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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Fumihiro ARAKAWA et al.

Group Art Unit: 1792

Application No.: 10/550,948

Examiner: R. CULBERT

Filed: September 28, 2005

Docket No.: 125505

For: ELECTROMAGNETIC SHIELDING SHEET, FRONT SHEET FOR DISPLAY AND
ELECTROMAGNETIC SHIELDING SHEET MANUFACTURING METHOD

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the January 24, 2008 Restriction Requirement, Applicants provisionally elect Group I, claims 1-4 and 6, with traverse.

National stage applications filed under 35 U.S.C. §371 are subject to unity of invention practice as set forth in PCT Rule 13, and are not subject to U.S. restriction practice. See MPEP §1893.03(d). PCT Rule 13.1 provides that an "international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept." PCT Rule 13.2 states:

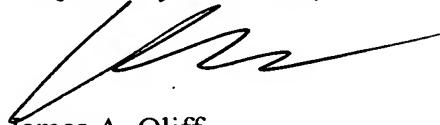
Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

A lack of unity of invention may be apparent "*a priori*," that is, before considering the claims in relation to any prior art, or may only become apparent "*a posteriori*," that is, after taking the prior art into consideration. See MPEP §1850(II), quoting *International Search and Preliminary Examination Guidelines* ("ISPE") 10.03. Lack of *a priori* unity of invention only exists if there is no subject matter common to all claims. *Id.* If *a priori* unity of invention exists between the claims, or, in other words, if there is subject matter common to all the claims, a lack of unity of invention may only be established *a posteriori* by showing that the common subject matter does not define a contribution over the prior art. *Id.*

The Office Action does not establish that each and every element of the subject matter that is common to independent claims 1, 4 and 5 are known in the prior art. Because there is common subject matter between the independent claims, a lack of unity of invention may only be established *a posteriori* by showing that the common subject matter does not define a contribution over the prior art. Instead, the Office Action asserts that "the recited reflection Y value greater than 0 and not greater than 20," in claims 1 and 4, "is simply an inherent physical property of the prior art blacking treatments," but fails to support this assertion by citing to any prior art of the record. Therefore, Applicants respectfully submit that lack of unity of invention has not been established, and thus a restriction requirement based on a lack of unity of invention is improper.

Thus, withdrawal of the Restriction Requirement is respectfully requested.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Randi B. Isaacs
Registration No. 56,046

JAO:RBI/tbm

Date: February 22, 2008

OLIFF & BERRIDGE, PLC
P.O. Box 320850
Alexandria, Virginia 22320-4850
Telephone: (703) 836-6400

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